Applicants thank the Examiner for the courtesy extended in the interview of June 13, 2001, concerning the first action on the merits issued May 10, 2001. Applicants note the rejections of record set forth in the Office Action of May 10, 2001, have not been repeated in the replacement Office Action issued October 25, 2001, and are therefor considered to be withdrawn under PTO practice. *Paperless Accounting, Inc., v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663 (Fed. Cir. 1986); see also MPEP 707.07(e).

Restriction Under 35 U.S.C. 121

Claims 1-66 were subject to restriction under 35 U.S.C. 121 into two Groups:

Group I, claims 1-42 drawn to methods for treating neovascularization, classified in Class 514, subclass 575; and

Group II, claims 43-66 directed to ophthalmic compositions for treating neovascularization, classified in class 514, subclass 912.

Applicants acknowledge their election with traverse of Group I, claims 1-42, made during a telephone interview with Examiner Ozga on May 7, 2001. Applicants contend that the Examiner's basis for restriction, that "batimastat can be used to promote general health instead of treating neovascularization" fails to establish a substantive basis for restriction for at least two reasons. First, the Examiner is arguing that the product batimastat can be used in a materially different process (MPEP §8.05(h)); however, claims 43-66 are not drawn to batimastat, but rather to ophthalmic compositions comprising batimastat. The Examiner has not established how an ophthalmic composition comprising batimastat "can be used to promote general health instead of treating neovascularization." See the Office Action dated October 25, 2001, at page 2. Second, the Examiner asserts that an undue burden to search the additional invention of group II exists based

upon the premise that the subject matter is divergent from that of Group I. The Examiner, however, fails to address how a complete search of the dependent claims of group I could be conducted without addressing the compositions recited therein, which are common to Groups I and II.

For the foregoing reasons, Applicants respectfully traverse the restriction requirement, and request the Examiner to consider rejoining and examining all claims.

Rejection under 35 U.S.C. 102

Claims 1-44 stand rejected under 35 U.S.C. 102(a) as being anticipated by Bowman *et al.*, WO 00/07565. Without in any way acquiescing to the propriety of the rejection, Applicants have amended the specification of the application to include a priority claim to U.S. Patent Application 09/127,920. Applicants respectfully submit that this amendment, which sets forth a valid priority claim under 35 U.S.C. 120 to the U.S. parent of WO 00/07565, obviates the rejection of record. Applicants respectfully submit that this is in keeping with the provisions of MPEP 706.02(b)(F), which states in the relevant parts:

> A rejection based on 35 U.S.C. 102(a) can be overcome by: . . .
>
> (F) Perfecting priority under 3 U.S.C. 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a).

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the rejection of record.

Conclusion

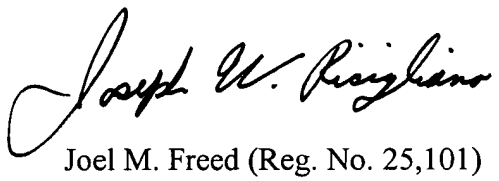
In view of the foregoing amendments, Applicants believe the application is in condition for allowance and solicit a Notice of Allowance indicating such at the earliest possible time.

Applicants do not believe that any fees are due in conjunction with this filing. However, if any fees

are required, then the Commissioner is authorized to deduct the fees from Arnold & Porter Deposit Account No. 50-1824 referencing matter 13587.286.

The Examiner is encouraged to contact the undersigned should any additional information be necessary.

Respectfully submitted,



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